

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE GROUP DIRECTOR REPRESENTING THE
COMMISSIONER OF PATENTS AND TRADEMARKS

#42
1-29-99
sfw

EX PARTE JAMES H. ALLEMAN

APPLICATION 08/252,984

OPPOSITION TO REOPENING PROSECUTION

This case is before the Group Director by reason of the request of Examiner Matar to reopen prosecution of the application under 37 C.F.R. § 1.198, after the Board reversed the Examiner on all grounds. On October 6, 1998, Examiner Zele granted a telephone interview to Dr. Alleman, the inventor, and undersigned counsel, regarding further prosecution of this application following the reversal by the Board of Appeals and Interferences on August 13, 1998. Examiner Zele reported that she no longer supervises Examiner Matar, and that she had not seen the Final Rejection in the Continuation application Serial No. 08/798,115 or the Appeal Brief in that case. She believed that her task was to advise the Group Director regarding both the present parent application as well as the Continuation case.

This memorandum is directed to the question of whether the parent case must be linked to the Continuation case. Examiner Zele assumed that they should be, because the claims in the two cases are similar. However, applicant seeks a Notice of Allowance in the parent case only, leaving the Continuation case, which has been made Special by a Decision on a Petition to Make Special, for review of the new theories advanced by Examiner Matar since the 1995 appeal in the present case.

1. A HIGHER STANDARD APPLIES AFTER REVERSAL BY THE BOARD.

Examiner Zele correctly pointed out that M.P.E.P. 1214.04 governs the present situation, where all of the rejections of the claims were reversed in their entireties. The authority for this M.P.E.P. section is 37 C.F.R. § 1.197(a), which provides that after a decision by the board, the case is returned to the examiner for such action as required "to carry into effect the decision" of the board (M.P.E.P. 1214). The only possible way to "carry into effect" a decision where all grounds were reversed is to issue a Notice of Allowance. The Board did not suggest that a new ground of rejection be considered (M.P.E.P. 1214.01). Rather, there was a "complete reversal of the examiner's rejection" (M.P.E.P. 1214.04).

In such a case, upon remand the examiner must "give full faith and credit" to the search leading to the Final Rejection that was appealed (M.P.E.P. 1214.04). Further, that section expressly states that the "examiner should *never* regard such a reversal as a challenge to make a new search to uncover other and better references" (emphasis supplied). However, that is precisely what Examiner Matar has done here. True, the new search was not done *after* the reversal. It was done before issuing the final rejection in the Continuation case in December, 1997. It was, however, a new search done *after* the final rejection in the parent case. For whatever reason, Examiner Matar decided that the rejections in the parent case were not adequate, and he added several new grounds in the Final Rejection of the continuation case. Now, he intends to add the new grounds in a

proposed reopening of the prosecution. In short, he feared reversal of the Final Rejection in the parent case and took that as a "challenge to make a new search to uncover other and better references." This is not an action designed "to carry into effect the decision" of the Board, as 37 C.F.R. § 1.197 requires. Rather, it is an after-the-fact search to make up for the acknowledged deficiencies of the Final Rejection in the parent case. M.P.E.P. 1214.04 expressly prohibits such a "challenge" search.

If Examiner Matar desires to test his new theories about rejecting a 1992 effective filing date using the International Callback Book, published in 1995, after the appeal in the parent case was filed and briefed, he may do so in the Examiner's Answer due shortly in the Continuation case. If his new theories prove valid, and the patent on the parent case has issued, then anyone against whom the patent is asserted in the future would have a defense based upon Examiner Matar's creative rejection of a 1992 application based upon 1995 art, assuming that the theory is accepted by the Board and the Federal Circuit.

It is important to realize that the mandate now is to carry into effect the Board decision. It is *not* to appeal the Board decision. The "Commissioner may not appeal adverse decisions of the Board of Appeals" *Brenner v. Manson*, 383 U.S. 519 (1966). The only possible control that the Commissioner may have over Board decisions is to expand a Board panel to pass upon an examiner's request for reconsideration *In re Alappat*, 33 F. 3d 1526 (Fed. Cir. 1994).

Here, the time has passed for a request for reconsideration, one of the two options provided in M.P.E.P. 1214.04. Therefore, there can be no resubmission to the Board, even if the Group Director and the Assistant Commissioner for Patents wanted to. The important point is that the decision to seek reconsideration is not left to Examiner Matar, even if he is now a Primary Examiner. Rather, a higher level of scrutiny is needed for a request for reconsideration, both to the Group Director and to the Assistant Commissioner. Such action should not be taken lightly.

So too is there a higher standard for reopening prosecution when there is a complete reversal. Where, as here, the new search was conducted simply as a challenge to keep applicant from obtaining a patent, review by cooler heads is required. Both the supervisor and the Group Director must sign off on this extraordinary action, which is directly contrary to carrying into effect the decision of the Board.

3. THE DOCTINE OF RES JUDICATA BARS REOPENING PROSECUTION FOR ANOTHER BITE AT THE IDT APPLE.

It is error to look to the Continuation case to see whether the proposed new rejection is raised there. The doctrine of *res judicata* bars the holding in a later case directly contrary to a holding in an earlier case. The Final Rejection in the Continuation case is bound to be governed by the Board decision in this case. Therefore, it is irrelevant whether the new theories of rejection of 1992 claims on a 1995 International Callback Book are raised in the Continuation case. The new theory could not have been raised before the Board in this case,

because the book was not even published when the present Final Rejection was made.

By the same token, the doctrine of *res judicata* probably will bar the rejection at page 14 of the Final Rejection in the Continuation case, namely, namely, that the claims are rejected under 35 U.S.C. § 103(a) based upon "IDT international callback services ... in view of Curtin and/or Riskin" and Examiner's Exhibit C. The Board expressly refused to adopt the rejection grounded on IDT in this case, because the popular magazine, not a technical journal, referring to IDT as a corporation, simply failed to show any structure. Once the linchpin of the IDT mention has been removed, the secondary references in the rejection have little chance of establishing that the claimed invention is obvious. The afterthoughts of Curtin and Riskin are tossed into the mix because they use the term "DID." This is hindsight reconstruction of the prior art.

No claim of the Alleman invention asserts that he invented DID. The specification, at page 12, lines 6 and 7, points out that "the present invention advantageously utilizes the Direct Inward Dial (DID) numbers." This is an acknowledgement that DID was in the prior art. The invention is to "advantageously use" the prior art idea in international callback. Riskin and Curtin are nothing more than what the inventor acknowledged in the specification: DID is old. The rejection on page 14 in the later Continuation case assumes that IDT shows international callback, and Curtin and Riskin show that it can advantageously use DID. The rejection must fail, however, when the

linchpin of IDT is removed, as it must be in view of the Board decision in this case.

The point is that *res judicata* means that the earlier case bars the later case. The fact that Riskin and Curtin were only found after Examiner Matar rose to the "challenge" of finding other and better references than he found in the parent case does not mean that they can be incorporated into the earlier case by reopening prosecution. The later case cannot control the result of the earlier case. The decision in the Continuation case will have to await action by the Board in due course. It cannot be made to jump ahead of the disposition of this case.

4. RISKIN WAS CONSIDERED AND DISCARDED IN SEARCHING THIS CASE.

Normally, in reopening prosecution, it is to consider new art that was not available to the examiner when the first search was conducted. For example, if a long time passed in prosecution of the prior art patent, it may have issued after the date of the first search, and yet have a filing date well before the application in question. Here, however, the Curtin and Riskin patents were both issued long before the 1992 filing date of the present invention. Both Curtin and Riskin were classified in Class 379. We know that Examiner Matar searched ten subclasses in Class 379 from his search notes in the file wrapper. One of those was 379/201, where the Riskin patent was also classified. Examiner Zele stated that the Riskin patent might have been out of the shoe on the day Examiner Matar searched 379/201, but that is not giving "full faith and credit" to the earlier search,

as required by M.P.E.P. 1214.04. It must be presumed that Examiner Matar considered Riskin in his search in the present case, and discarded it as being no more pertinent than the acknowledgement in the specification that DID is old.

Certainly, there is no teaching in either Curtin or Riskin that DID can be used in international callback. The concept of international callback is nowhere even suggested in either Curtin or Riskin. Because Examiner Matar treats Curtin and Riskin as equivalent teachings of DID ("Curtin and/or Riskin" in the Final Rejection of the Continuation case), the fact that Riskin was in fact in the very class and subclass searched in the present case should be sufficient to show that the concept of DID was known to be old from the search that was conducted, in addition to the fact that the specification acknowledges the fact.

Certainly there is no basis to reopen the prosecution to reconsider patents in 379/201, since the prior search, which must be given full faith and credit, has already done so.

5. THE PROPOSED REHASH OF OLD, PREVIOUSLY DISCARDED ART

DOES NOT RISE TO THE LEVEL OF IMPORTANCE FOR THE GROUP DIRECTOR TO APPROVE.

M.P.E.P. 1214.04 expressly refers to M.P.E.P. § 1002(c) and § 1214.07.

Both are instructive in this case. Item 2 of 1002.02(c) shows that reopening prosecution after decision by the Board "where no court action has been filed" is frowned upon. No court action could be filed here, because the Commissioner cannot appeal a Board decision, and Applicant cannot appeal a complete reversal of the examiner on all grounds. The Federal Circuit has no jurisdiction

to review rejections reversed by the Board. *In re Hayashibara*, 188 USPQ 4, (CCPA 1975).

Section 1214.07 begins by quoting 37 C.F.R. § 1.198, that cases decided by the Board "will not be reopened or reconsidered by the primary examiner ... without the written authority of the Commissioner." In other words, there should be finality in Board decisions, and their effect should be carried out. The remainder of M.P.E.P. 1214.07 deals with a request by *applicant*, not the Examiner, to amend the claims. That clearly is not the present case, where the applicant seeks a Notice of Allowance straightaway, with no further delay. The Continuation case was made Special by reason of proof of infringement in the marketplace, so the grant of a patent is urgently sought.

Here, rehashing the previously searched art for a better reference to show what applicant has acknowledged in the specification, namely, that DID is old, fails to rise to the level of importance that prosecution should be reopened. This is not a matter that the Commissioner should decide, through his delegate, the Group Director, instead of carrying out the mandate of 37 C.F.R. § 1.197. The Code requires the Examiner to "carry into effect the decision" of the Board.

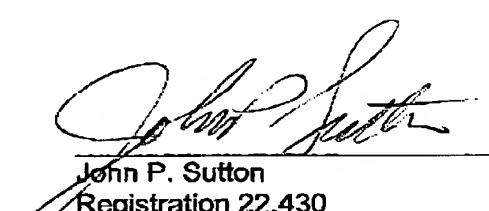
CONCLUSION

The only way to "carry into effect the decision" of the Board, reversing the examiner on all grounds, is to issue a Notice of Allowance. The request to reopen the prosecution to consider art previously considered and discarded should be denied. No decision need be made in the Continuation case until the Examiner's Answer is reviewed in light of the Board decision in the present case.

The Examiner's Answer in the Continuation case is due shortly, and should be considered on its own merits, and not used to delay issuance of the present patent application.

Respectfully submitted,

8 Oct 1996


John P. Sutton
Registration 22,430

CERTIFICATE OF MAILING (37 CFR § 1.8(A))

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